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JUN 03 2005

OFFICE OF PETITIONS

In re Application of
Najam, et al.
Application No. 09/858,324
Filed: May 15, 2001
Attorney Docket No. 10736/8

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: DECISION DISMISSING PETITIONS
: UNDER § 1.48(a) and § 1.183
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This is a combined decision on the "PETITION UNDER 37 C.F.R. § 1.48(a)(1) AND AMENDMENT TO CORRECT INVENTORSHIP" and the "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE A REQUIREMENT UNDER 37 C.F.R. § 1.48", filed March 3, 2005, to waive the requirement under § 1.48(a)(3) for execution of the declaration by all of the actual inventors.

The petition under 37 CFR 1.48(a) is DISMISSED.

The petition under 37 CFR 1.183 is DISMISSED.

Petitioner is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petitions Under 37 CFR 1.48(a) and 37 CFR 1.183" and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on May 15, 2001. A properly executed declaration identifying inventors Zahid Najam, Peder J. Jungck, Macduy T. Vu, and Andrew T. Nguyen was filed on August 29, 2001, in response to a Notice to File Missing Parts mailed July 20, 2001. On March 3, 2005, the instant request under was filed to amend the inventorship to add joint inventor Gregory Scott Triplett. Accompanying the petition was a statement from added inventor Triplett, stating that the inventorship error occurred without deceptive intention; and a declaration executed by Najam, Jungck, Vu, and Triplett.

37 CFR 1.48(a) requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the inventorship error occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

Petitioner has satisfied requirements (1), (2), and (4) above. However, the petition does not include a proper written consent of assignee CloudShield Technologies, Inc. Petitioner's written consent is signed by Peder Jungck, who is identified as "Chief Technical Officer". Regarding 37 CFR 3.73(b) statements and who may sign on behalf of an assignee, the Manual of Patent Examining Procedure § 324 states:

- (A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. 37 CFR 3.73(b)(2)(ii). An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. A person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. A power of attorney (37 CFR 1.34(b)) from the inventors or the assignee to a patent practitioner to prosecute a patent application does not make the practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee.

(B) The submission may be signed by any person, if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee. 37 CFR 3.73(b)(2)(i).

(C) The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record.

Where a submission does not comply with (A), (B), or (C) above, evidence of the person's authority to sign will be required.

On renewed petition, petitioner must supply a 3.73(b) statement signed by an officer who has apparent authority to sign on behalf of the organization. Alternatively, the 3.73(b) statement can be signed by an individual who states that he or she has the authority to sign on behalf of the assignee.

With respect to petitioner's 37 CFR 1.183 petition, petitioner requests waiver of the requirement that all of the inventors sign the declaration on the basis that the Nguyen is "unavailable" to sign the declaration setting forth the correct inventive entity.

Under 37 CFR 1.183, any requirement of the regulations, which is not a requirement of the statutes, may be waived by the Commissioner's designee in an extraordinary situation, when justice so requires. Waiver of the requirement is not yet appropriate in this instance. Petitioner has not provided a showing of his inability to reach Nguyen, merely a statement (conclusion) that Nguyen is unavailable. On renewed petition, petitioner must set forth the steps taken to locate Nguyen. See MPEP 201.03.

Petitioner submitted \$260 towards the petitions under 37 CFR 1.48 and 37 CFR 1.183. Effective December 8, 2005, the fee for a petition under 37 CFR 1.183 was increased from \$130 to \$400. Accordingly, the \$270 difference has been charged to Deposit Account No. 23-1925, as authorized.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (703) 872-9306
Attn: Office of Petitions

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Telephone inquiries related to this decision may be directed to
the undersigned at (571) 272-3207.

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